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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,135	07/13/2004	Fabio Gianniessi	4865-13	7877
23117 7590 03/17/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER YOUNG, SHAWQUITA				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
03/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,135

Applicant(s)

GIANNESI ET AL.

Examiner

SHAWQUIA YOUNG

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/23/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5 is/are allowed.
- 6) ☒ Claim(s) 1,3,7,9,10 and 12 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 3-5, 7, 9, 10 and 12 are currently pending in the instant application. Applicants have cancelled claims 2 and 11 in an amendment filed on December 23, 2008. Claims 1, 3, 7, 9, 10 and 12 are being rejected; claim 4 is being objected and claim 5 is considered allowable.

I. *Response to Arguments*

Applicant's amendment, filed December 23, 2008, has overcome the rejection of claims 1, 3, 4 and 5 under 35 USC 102(b) as being anticipated by Crandall, et al. and the rejection of claims 2, 3 and 11 under 35 USC 112, second paragraph for lacking antecedent basis. The above rejections have been withdrawn. Applicants have not overcome the rejection of claim 12 under 35 USC 102(b) as being anticipated by Crandall, et al. This rejection has been maintained.

II. *Rejection(s)*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

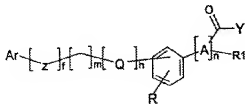
A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by *Crandall, et*

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al. (See RN 24220-48-2, CAPLUS). The instant invention claims a product with the



formula

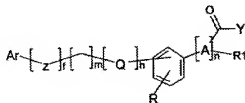
wherein **A** is CH, alkanylidene with 2 to 4

carbon atoms or alkenylidene with 2 to 4 carbon atoms; **Ar** is phenyl optionally substituted by halogens, NO₂, OH, C₁₋₄ alkyl and alkoxy, said alkyl and alkoxy optionally substituted by at least one halogen; **f** is the number 0 or 1; **h** is the number 0 or 1; **m** is a whole number from 0 to 3; **n** is the number 0 or 1 and if **n** is 0, **R₁** is absent and COY is directly bound to benzene; **Q** is oxygen; **Z** is as defined in claim 12; **R** is selected from **R₂** and OR₂; **R₁** is as defined in claim 12; and all other variables are as defined in claim 12.

The *Crandall, et al.* reference teaches the compound [4-(phenylmethoxy)phenyl] diethyl ester propanedioic acid (See RN 24220-48-2, CAPLUS). This species of compound anticipates the genus compound of the instant invention, wherein the genus structure and its definitions are stated above.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 7, 9, 10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by *Brooks, et al.* (US 7,192,982). The instant invention claims a product with



the formula
$$\text{Ar} \left[\text{Z} \right]_f \left[\right]_m \text{Q} \left[\right]_h \text{C}_6\text{H}_3(\text{R}) \left[\text{A} \right]_n \text{R}_1$$
 wherein **A** is CH, alkanylidene with 2 to 4 carbon atoms or alkenylidene with 2 to 4 carbon atoms; **Ar** is phenyl optionally substituted by halogens, NO₂, OH, C₁₋₄ alkyl and alkoxy, said alkyl and alkoxy optionally substituted by at least one halogen; **f** is the number 0 or 1; **h** is the number 0 or 1; **m** is a whole number from 0 to 3; **n** is the number 0 or 1 and if **n** is 0, **R**₁ is absent and COY is directly bound to benzene; **Q** is oxygen; **Z** is as defined in claim 12; **R** is selected from **R**₂ and OR₂; **R**₁ is as defined in claim 12; and all other variables are as defined in claim 12.

The *Brooks, et al.* reference teaches modulators of PPARs such as (2S)-3-[4-[3-(2,4-difluoro-phenoxy)-propoxy]-phenyl]-2-methoxy-propionic acid (See ex. 106, column 137). This species of compound anticipates the genus compound of the instant invention, wherein the genus structure and its definitions are stated above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation “Q is oxygen or HNC(O)O” which

is dependent on claim 1 but the group HNC(O)O is not found in the definition of variable Q in claim 1. There is insufficient antecedent basis for this limitation in the claim.

III. Objections

Dependent Claim Objections

Dependent Claim 4 is also objected to as being dependent upon a rejected based claim.

IV. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626